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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/630,085 | 07/30/2003 | Dominick M. Seminara | 4988.001 | 8477 |

7590 12/02/2004
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| EXAMINER |
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HAN, JASON

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| ART UNIT | PAPER NUMBER |
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2875

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/630,085 | Applicant(s) SEMINARA ET AL. | |
| | Examiner Jason M Han | Art Unit 2875 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081).
3. With regards to Claim 1, Wilbur discloses an illumination device including:
 - first and second panels [Figures 1-3: (12, 14)], wherein at least one light emitting device [Figures 1-3: (52)] is electrically connected to a battery power source [Figures 1-3: (54); Column 3, Line 55];
 - whereby the first and second panels being pivotally connected [Figures 1-3: (16)] and configurable between a closed configuration wherein the panels are disposed in face to face relation, and an open configuration wherein the panels are disposed in a generally planar side by side relation [Figures 1-3]; and
 - means for electrically connecting the light emitting devices to the battery power source when the panels are configured in the open configuration and for electrically disconnecting the light emitting devices from the battery source when the panels are configured in the closed configuration [Column 3, Lines 31-45].

Wilbur does not specifically teach at least one light emitting device being located on both the first and second panels.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included at least one light emitting device on both the panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, mere duplication of the light emitting devices to be disposed on both panels is an obvious design preference, whereby providing additional light sources to a display enhance aesthetic appeal, as well as ostentatious warning when used as a safety device.

It should be noted that the recitation that "an illuminated personal safety device" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

4. With regards to Claim 2, Wilbur discloses the claimed invention as cited above. In addition, Wilbur provides means for electrically connecting the light emitting devices to the battery power source via at least one set of electrical contacts [Figures 1-3: (46, 48)], whereby the electrical contacts are disposed in mating engagement when the panels are configured in the open configuration and disposed in spaced relation when the panels are configured in the closed configuration [Column 3, Lines 31-45].

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5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) as applied to Claim 1 above, and further in view of Chien (U.S. Patent 5688038).

Wilbur discloses the claimed invention as cited above, but does not teach the illumination device providing means for mounting onto a bicycle or to a person.

Chien teaches a protective device with E.L. light means that provides means for mounting onto a bicycle [Figures 6-12: (26)] or onto a person [Figures 1-5: (4, 6, 6')].

It would have been obvious to modify the illumination device of Wilbur to incorporate the mounting means of Chien in order to provide a compact, flexible, and easily accessible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) as applied to Claim 1 above, and further in view of Schott et al. (U.S. Patent 4559516).

Wilbur discloses the claimed invention as cited above, but does not teach the first and second panels including at least one light emitting device adapted to function as a turn signal, nor means for selectively activating one of the turn signals in response to the angular position of the safety device.

It should be noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the

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ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

Regardless, Schott teaches a helmet with turn signal indicators disposed at separate ends on the helmet [Figures 1-3: (14, 16)]. In addition, Schott teaches a means [e.g. tilt switches] for selectively activating one of the turn signals in response to the angular position [see Abstract].

It would have been obvious to modify the illumination device of Wilbur to incorporate the turn signals of Schott in order to provide a compact and flexible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user. In this case, the safety device further provides additional warning with respect to a user's directional movement.

The examiner makes further note that by combining the two references a user is provided with an illuminated warning device, which may be dismounted if the user desires to remain inconspicuous.

7. Claims 6-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516):

8. With regards to Claim 6, Wilbur discloses an illumination device including:

- first and second panels [Figures 1-3: (12, 14)], wherein at least one light emitting device [Figures 1-3: (52)] is electrically connected to a battery power source [Figures 1-3: (54); Column 3, Line 55];

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- whereby the first and second panels being pivotally connected [Figures 1-3: (16)] and configurable between a closed configuration wherein the panels are disposed in face to face relation, and an open configuration wherein the panels are disposed in a generally planar side by side relation [Figures 1-3]; and
- means for electrically connecting the light emitting devices to the battery power source when the panels are configured in the open configuration and for electrically disconnecting the light emitting devices from the battery source when the panels are configured in the closed configuration [Column 3, Lines 31-45].

Wilbur does not specifically teach at least one light emitting device being located on both the first and second panels, nor the panels further including illuminated turn signals that are selectively activated in response to the angular position of the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included at least one light emitting device on both the panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, mere duplication of the light emitting devices to be disposed on both panels is an obvious design preference, whereby providing additional light sources to a display enhance aesthetic appeal, as well as ostentatious warning when used as a safety device.

In addition, Schott teaches a helmet with turn signal indicators disposed at separate ends on the helmet [Figures 1-3: (14, 16)]. Schott further teaches a means for selectively activating one of the turn signals in response to the angular position [see Abstract].

It would have been obvious to modify the illumination device of Wilbur to incorporate the turn signals of Schott in order to provide a compact and flexible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user. In this case, the safety device further provides additional warning with respect to a user's directional movement.

The examiner makes further note that by combining the two references a user is provided with an illuminated warning device, which may be dismounted if the user desires to remain inconspicuous.

9. With regards to Claim 7, Wilbur in view of Schott discloses the claimed invention as cited above. In addition, Schott teaches the means for selectively activating the turn signals including at least one tilt switch [see Abstract; Column 2, Lines 30-46].

10. With regards to Claim 8, Wilbur in view of Schott discloses the claimed invention as cited above. In addition, Wilbur teaches means for displaying illuminated indicia [Figures 9A-9B].

11. With regards to Claim 9, Wilbur in view of Schott discloses the claimed invention as cited above. In addition, Wilbur teaches, "The illumination source may be visible directly through the aperture(s) or the aperture(s) may be covered

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with a transparent or translucent film to be illuminated from the rear by the light source. The film may, for example, be a conventional photographic slide transparency which is lighted for viewing by opening the card [Column 2, Lines 3-9]."

12. With regards to Claim 12, Wilbur in view of Schott discloses the claimed invention as cited above. In addition, Schott teaches means for mounting the device to a person [Figures 1-3: (10) – helmet].

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516) as applied to Claim 6 above, and further in view of Branom (U.S. Patent 4709307).

Wilbur in view of Schott discloses the claimed invention as cited above, but does not specifically teach the illumination device providing means for displaying illuminated indicia including a plurality of light emitting devices arranged to collectively form the indicia when illuminated.

Branom teaches clothing with illuminated display wherein a plurality of light emitting devices are arranged collectively to form an indicia when illuminated [Figure 1: (21)].

It would have been obvious to modify the illumination device of Wilbur with the turn signal of Schott to further incorporate the indicia of Branom in order to specifically [e.g. via text] warn a user's surrounding. Such a limitation is commonly known in the art and is considered an obvious design preference.

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14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516) as applied to Claim 6 above, and further in view of Chien (U.S. Patent 5688038).

Wilbur in view of Schott discloses the claimed invention as cited above, but does not teach the illumination device providing means for mounting onto a bicycle.

Chien teaches a protective device with E.L. light means that provides means for mounting onto a bicycle [Figures 6-12: (26)].

It would have been obvious to modify the illumination device of Wilbur with the turn signals of Schott to further incorporate the mounting means of Chien in order to provide a compact, flexible, and easily accessible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user. In this case, providing additional mounting means for placement on a bicycle grants a user a device that does not have to be worn.

15. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516).

16. With regards to Claim 13, Wilbur discloses an illumination device including:

- first and second panels [Figures 1-3: (12, 14)], wherein at least one light emitting device [Figures 1-3: (52)] is electrically connected to a battery power source [Figures 1-3: (54); Column 3, Line 55];

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- whereby the first and second panels being pivotally connected [Figures 1-3: (16)] and configurable between a closed configuration wherein the panels are disposed in face to face relation, and an open configuration wherein the panels are disposed in a generally planar side by side relation [Figures 1-3]; and
- means for electrically connecting the light emitting devices to the battery power source when the panels are configured in the open configuration and for electrically disconnecting the light emitting devices from the battery source when the panels are configured in the closed configuration [Column 3, Lines 31-45].

Wilbur does not specifically teach at least one light emitting device being located on both the first and second panels, nor the panels further including secondary light emitting devices disposed at the distal ends of each panel that serve as turn signals that are selectively activated in response to the angular position of the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included at least one light emitting device on both the panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, mere duplication of the light emitting devices to be disposed on both panels is an obvious design preference, whereby providing additional light sources to a display enhance aesthetic appeal, as well as ostentatious warning when used as a safety device.

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In addition, Schott teaches a helmet with turn signal indicators disposed at distal ends on the helmet [Figures 1-3: (14, 16)]. Schott further teaches a means for selectively activating one of the turn signals in response to the angular position with respect to a horizontal plane of a user [see Abstract].

It would have been obvious to modify the illumination device of Wilbur to incorporate the turn signals of Schott in order to provide a compact and flexible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user. In this case, the safety device further provides additional warning with respect to a user's directional movement.

Lastly, the examiner makes note that by combining the two references a user is provided with an illuminated warning device, which may be dismounted if the user desires to remain inconspicuous. The examiner also considers the references functionally equivalent in meeting all the limitations of the claim.

17. With regards to Claim 16, Wilbur in view of Schott discloses the claimed invention as cited above. In addition, both Wilbur [Column 5, Lines 40-50] and Schott [Figures 1-3: (38, 40)] teach the light emitting devices blinking when illuminated.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516) as applied to Claim 13 above, and further in view of Chien (U.S. Patent 5688038).

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Wilbur in view of Schott discloses the claimed invention as cited above, but does not teach the illumination device providing means for mounting onto a bicycle.

Chien teaches a protective device with E.L. light means that provides means for mounting onto a bicycle [Figures 6-12: (26)].

It would have been obvious to modify the illumination device of Wilbur with the turn signals of Schott to further incorporate the mounting means of Chien in order to provide a compact, flexible, and easily accessible safety device for use in low lighting conditions. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment of a user. In this case, providing additional mounting means for placement on a bicycle grants a user a device that does not have to be worn.

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbur (U.S. Patent 4363081) in view of Schott et al. (U.S. Patent 4559516) as applied to Claim 13 above, and further in view of de Haas et al. (U.S. Patent 5245516).

Wilbur in view of Schott discloses the claimed invention as cited above. In addition, Schott teaches means for mounting the device to a person [Figures 1-3: (10) – helmet], but neither Wilbur nor Schott specifically teaches the illumination device providing a belt for mounting the device to a person.

de Haas teaches a portable illumination device that includes a belt [Figure 1 : (1)] for mounting the device to a person.

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It would have been obvious to modify the illumination device of Wilbur with the turn signals of Schott to further incorporate the belt of de Haas in order to provide a user a hands-free means for warning others in close proximity of the user's presence. Such lighting devices are commonly held in the art, whereby an illuminated panel provides warning to the surrounding environment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references have been cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

| | |
|---|--|
| US Patent 3945336 to Harris; | US Patent 4328533 to Paredes; |
| US Patent 4497126 to Dejean; | US Patent 4652981 to Glynn; |
| US Patent 4860177 to Simms; | US Patent 4928084 to Reiser; |
| US Patent 5358461 to Bailey, Jr.; | US Patent 5424922 to Wise; |
| US Patent 5434759 to Endo et al; | US Patent 5479325 to Chien; |
| US Patent 5484292 to McTaggart; | US Patent 5523925 to Bare, IV; |
| US Patent 5566384 to Chien; | US Patent 5617303 to Izzo, Sr.; |
| US Patent 5684244 to Jones; | US Patent 5690411 to Jackman; |
| US Patent 5803574 to Szaniszlo; | US Patent 5806960 to Chien; |
| US Patent 5988825 to Masters et al; | US Patent 6011545 to Henderson et al; |
| US Patent 6109770 to Choimet et al; | US Patent 6140934 to Lam; |
| US Patent 6154945 to Voelzke; | US Publication 2001/0036074 to Wang; |
| US Patent 6456273 to Want et al; | US Publication 2002/0145864 to Spearing; |
| US Publication 2002/0159246 to Murasko et al; | US Patent 6595666 to Exilien; |

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US Patent 6679615 to Spearing;

US Patent 6698903 to Hall;

US Patent 6753788 to Munyon;


US Patent 6016101 to Brown.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (11/28/2004)



JOHN ANTHONY WARD
PRIMARY EXAMINER